



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,143	04/16/2004	Phillip Mackie	2625-1-002CON	8753
23565	7590	05/03/2005	EXAMINER	
KLAUBER & JACKSON 411 HACKENSACK AVENUE HACKENSACK, NJ 07601			CAMERON, ERMA C	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 05/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/826,143

Applicant(s)

MACKIE ET AL.

Examiner

Erma Cameron

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) 24,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/17/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The preliminary amendment of 8/13/2004 shows claims 1-12 as canceled and has NEW claims 13-25. However, the application as filed had claims 1-15.

The examiner is assuming for examination purposes that original claims 1-15 have ALL been canceled, and that the NEW claims should start at 16.

Therefore, misnumbered claims 13-26 been renumbered 16-28.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 16-26 (renumbered), drawn to a method of coating, classified in class 427, subclass 385.5.
  - II. Claims 27-28 (renumbered), drawn to an article, classified in class 428, subclass 411.1+.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process, such as a lamination process.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. This application contains claims directed to the following patentably distinct species of the claimed invention:

a) one species of flexible component;

Art Unit: 1762

b) one species of retentive component.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 13 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. During a telephone conversation with David Smith on March 24, 2005 a provisional election was made WITH traverse to prosecute the invention of Group I, claims 16-26, polybutadiene as the flexible component, and bisphenol as the retentive component. Affirmation of this election must be made by applicant in replying to this Office action.

Polybutadiene was not found as the flexible component, nor bisphenol as the retentive component. However, the prior art teaches silane and siloxane copolymers as both the flexible and retentive components.

Claims 24, 27 and 28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 1762

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 16-23 and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) The amendment to second paragraph, page 4 in the 8/13/2004 amendment:

“...Suitable copolymers which have retentive properties...” is new matter. The original specification merely described these copolymers as “suitable”.

b) The amendment to the bridging paragraph between pages 4 and 5 (8/13/2004 amendment):

“...Examples of the retentive components of such copolymers...” is new matter. Originally, the copolymers of the list were described as “suitable copolymers”, and the amendment changes the list to be the retentive components.

c) The amendment to the bridging paragraph between pages 4 and 5 (8/13/2004 amendment):

The last two lines have been improperly amended.

The last two lines originally were: “...provided that they comprise the required flexible and retentive components...”.

The amendment of 8/13/2005 changes “they” to “the copolymers also”, but leaves out “and retentive”, without indicating that it is deleted..

Art Unit: 1762

Besides being improperly amended, this is also new matter.

d) The amendment to the first full paragraph of page 5 (8/13/2004 amendment):

This is new matter. Nowhere in the original specification or claims are silanes, siloxanes, polybutadiene, polyethylene or polyacrylate said to be the flexible components.

e) Claim 23: the identity of the polymers as being the retentive component is new matter. In original claim 8 these species were identified as being copolymers, with no designation of whether they were flexible or retentive components.

f) Claim 25: the identity of the silane or siloxane polymers as being the retentive component is new matter. In original claim 10 these species were identified as being copolymers, with no designation of whether they were flexible or retentive components.

g) Claim 26: the polymers of claim 26 were not identified as being the flexible components in the specification or claims as originally filed.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



Art Unit: 1762

12. Claims 16-23 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 16, line 3: “prevention” should be “preventing”.

b) Claim 23: it is not clear why Bisphenol has been capitalized. This is not conventional.

### *Specification*

13. The amendment filed 8/13/2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a) The amendment to second paragraph, page 4 in the 8/13/2004 amendment:

“...Suitable copolymers which have retentive properties...” is new matter. The original specification merely described these copolymers as “suitable”, and did not designate them as ‘retentive’.

b) The amendment to the bridging paragraph between pages 4 and 5 (8/13/2004 amendment):

Art Unit: 1762

“...Examples of the retentive components of such copolymers...” is new matter.

Originally, the copolymers of the list were described as “suitable copolymers”, and the amendment changes the list to be the retentive components.

This is new matter.

c) The amendment to the bridging paragraph between pages 4 and 5 (8/13/2004 amendment):

The last two lines have been improperly amended.

The last two lines originally were: “...provided that they comprise the required flexible and retentive components...”.

The amendment of 8/13/2005 changes “they” to “the copolymers also”, but leaves out “and retentive”, without indicating that it is deleted.

Besides the fact that the amendment is improper, this is also new matter.

d) The amendment to the first full paragraph of page 5 (8/13/2004 amendment):

This is new matter. Nowhere in the original specification or claims are silanes, siloxanes, polybutadiene, polyethylene or polyacrylate said to be the flexible components.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 16-23 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feder (5140061) taken in view of Fischer et al.

'061 teaches an elastomeric coating to be applied to corks or other substrates (8:9-62), based on a polydimethylsiloxane (see Example 1) and an amino or amido silane. (see Abstract). It appears that because there is a curing catalyst present, that a copolymer will be formed. It is clear that there is a flexible component present because the coating composition is referred to as an elastomeric seal and is said to aid sliding of the cork into the bottle and avoiding leakage between the neck and the stopper (8:38-62).

'061 does not teach that one of the components of the coating composition is a component that will retain compounds such as TCA.

Fischer et al teach that polydimethylsiloxane very ably absorbs anisoles such as TCA (see entire document).

The polydimethylsiloxane of '061 therefore would inherently be able to absorb and retain anisoles such as TCA.

***Priority***

16. There should be a priority statement added to page 1.

Art Unit: 1762

***Oath/Declaration***

17. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Some of the signatures, dates, etc. are partially or completely illegible.

A clean or new copy should be supplied.

***Drawings***

18. The title of the drawing section in the specification should be Brief Description of the Drawings.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

Art Unit: 1762

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
ERMA CAMERON  
PRIMARY EXAMINER

Erma Cameron  
Primary Examiner  
Art Unit 1762

April 29, 2005